## REMARKS

The Final Office Action dated August 8, 2007 contained a final rejection of claims 1-20. The Applicant has amended claims 1, 6, 10, 15 and 18 and canceled claims 4, 8 and 14. Claims 1-3, 5-7, 9-13 and 15-20 are in the case. Please consider the present amendment with the attached Request for Continued Examination (RCE) under 37 C.F.R. § 1.114. This amendment is in accordance with 37 C.F.R. § 1.114. Reexamination and reconsideration of the application, as amended, are requested.

The Office Action objected to the disclosure due to minor informalities.

In response, the Applicant has amended the specification as suggested by the Examiner to overcome this objection.

The Office Action rejected claims 1-20 under 35 U.S.C. § 103(a) as being unpatentable over Kawamura et al. (U.S. Patent No. 6,931,138) in view of Kudo et al. (U.S. Patent No. 6,919,925) and further in view of Kincaid (U.S. Patent No. 7,072,477) and still further in view of Nagao (U.S. Patent No. 6,573,909).

The Applicant respectfully traverses this rejection based on the amendments to the claims and the arguments below.

The Applicant's claimed invention now includes an audio microphone and keeping an audio recording gain of the audio microphone at a same audio recording level while the zoom levels change during recording of the images. Support for these amendments can be found throughout the specification and at least in FIGS. 1-4 and paragraph [0023] of the Application specification (U.S. Patent Publication No. 2005/0099511).

In contrast, the combined references are missing the above **newly** added features as specifically claimed with the other elements of the Applicant's claimed invention. Although the combined references (four references were combined by the Examiner in one rejection) disclose a zoom microphone device (Kawamura et al.), video camera with buttons (Kudo et al.), an audio processing system that alters the audio playback in response to changes in the scene selected by the user (Nagao) and creating metadata corresponding to recorded audio (Kincaid), as argued by the Examiner, the combined references are still missing the newly added keeping an audio

recording gain of the audio microphone at a same audio recording level while the zoom levels change during recording of the images as specifically used with the other elements of the Applicant's claimed invention.

Further, even though the combined references do not disclose, teach, or suggest all of the features of the Applicant's claimed invention, the references should **not** be considered together because Kawamura et al. teach away from the Applicant's claimed invention. MPEP section 2143.01, part V. clearly states that "[I]f proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. In re Gordon, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). Also, MPEP section 2143.01, part VI. states that "[I]f the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. In re Ratti, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).

Namely, Kawamura et al. **explicitly** disclose that the "...present invention is directed to a ***zoom microphone*** device having an ***audio zooming function*** of effectively ***enhancing a target sound*** in accordance with a zoom position." [***emphasis added***] (see col. 3, lines 6-8 of Kawamura et al.). In fact, Kawamura et al. **requires** a microphone (pickup section as element 11 including microphones 16a and 16b of Kawamura et al.) to pickup and enhance the audio as the zoom level changes.

In contrast, the Applicant's claimed invention does **not** enhance microphone pickup to adjust volume levels in response to zoom levels, but instead keeps an audio recording gain of the audio microphone at a same audio recording level while the zoom levels change during recording of the images. In other words, the Applicant's claimed invention uses the sound output of the speakers to adjust volume in response to different zoom levels and **does not** use the microphone, which is **required** in Kawamura et al.

Consequently, the proposed modification or combination would render Kawamura et al. being modified unsatisfactory for its intended purpose and would change the principle of operation of the invention in Kawamura et al. being modified.

This is because Kawamura et al. explicitly **require** a zoom microphone device to **pickup audio at different zoom levels** and enhance the audio of a target as the zoom level changes, **unlike** the Applicant's newly claimed invention which keeps an audio recording gain of the audio microphone at a same audio recording level while the zoom levels change during recording of the images.

Therefore, this "teaching away" prevents this reference from being used by the Examiner. ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). Thus, since the Applicant's claimed elements are **not** disclosed, taught or suggested by the combined references and because Kawamura et al. **teach away** from the Applicant's invention, Kawamura et al. **cannot** be used as a reference alone or in combination with other references, and hence, the Applicant submits that the rejection should be withdrawn. *MPEP 2143.*

Also, the Examiner is reminded that these references **should not** be considered together with the benefit of hindsight. It is well-settled in the law that improper hindsight occurs when knowledge and advantages from the Applicant's disclosure is used or words or phrases are arbitrarily picked and chosen from references to recreate the Applicant's invention. Crown Operations International, Ltd. v. Solutia, Inc., 289 F.3d 1367, 62 USPQ2d 1917 (Fed. Cir. 2002). In particular, the combination of elements in a manner that reconstructs the Applicant's invention only with the benefit of **hindsight** is insufficient to present a prima facie case of obviousness. Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc., 796 F.2d 443, 230 USPQ 416 (Fed. Cir. 1986).

Even if the references in question seem relatively similar "...**the opportunity to judge by hindsight is particularly tempting**. Hence, the tests of whether to combine references need to be applied rigorously," especially when the Examiner uses a reference that does not explicitly disclose the exact elements of the invention or **teaches away** from the Applicant's claimed invention, which is the case here. McGinley v. Franklin Sports Inc., 60 USPQ 2d 1001, 1008 (Fed. Cir. 2001). Since hindsight cannot be used to support the rejections, the combined cited references cannot render the Applicant's invention obvious and the rejection is improper and should be withdrawn. Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc. Accordingly, this teaching away and the failure of the cited

references to disclose, suggest or provide motivation for the Applicant's claimed invention indicates a lack of a prima facie case of obviousness (MPEP 2143).

Further, with regard to the dependent claims, since they depend from the above-argued respective independent claims, they are therefore patentable on the same basis. (MPEP § 2143.03). Also, the other references cited by the Examiner also have been considered by the Applicant in requesting allowance of the dependant claims and none have been found to teach or suggest the Applicant's claimed invention.

Thus, it is respectfully requested that all of the claims be allowed based on the amendments and arguments. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue. Additionally, in an effort to further the prosecution of the subject application, the Applicant kindly **requests** the Examiner to telephone the Applicant's attorney at **(818) 885-1575**. Please note that all mail correspondence should continue to be directed to

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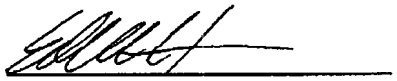

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